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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/847,967 04/22/97 GOLDWASSER

I 016703-00080

EXAMINER

HM22/0331

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ACHUTAMURTHY, P	
ART UNIT	PAPER NUMBER

1618

8

DATE MAILED:

03/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/847,967

Applicant(s)
Goldwasser et al

Examiner
P. Achutamurthy

Group Art Unit
1618



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-41 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

This application contains claims directed to the following patentably distinct species of the claimed invention: the delivery techniques for use in making array of materials selected from the group consisting of sputtering techniques, spraying techniques, laser ablation techniques, electron beam evaporation techniques, thermal evaporation techniques, ion-beam techniques, ion implantation techniques, doping techniques, chemical vapor deposition (CVD) techniques, and liquid dispensing techniques..

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently,, claim 24 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation conducted between Examiner Timothy Meeks and Attorney Ronald A. Krasnow on February 9, 1999 a provisional election was made with traverse to prosecute the invention of using electron beam evaporation techniques from the patentable distinct species of claim 24. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Rejection A

Claims 1-41 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific material exemplified in the specification, does not reasonably provide enablement for making an array of any type of materials as broadly called for in the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claims call for a method making an array of materials on a substrate which comprise adding two components of first and second material to specific locations on the substrate and allowing the components to react forming at least two different materials. Since the claims add not make it clear if the word "interact" is to be interpreted as chemical reaction or other type of reacting and since the material are obtained by combining two components of first and second material, it may involve combining such components to obtain at least two different materials in a manner that may be non-chemical in nature, the specification does not provide sufficient guidance to one having ordinary skill in the art to practice the invention as claimed with a reasonable expectation of success without an undue amount of experimentation. The method used to make

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the array, such in this present case, taking into consideration the lection of species that has been made, electron beam evaporation techniques, should be recited in the claim. The specification examples appear to be limited to chemical synthesis of compounds. There is no teaching in the specification of how to obtain materials different materials by combining two component of two materials by non-chemical means.

Rejection B

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drafted in confusing and contradictory manner. The claims do not distinguish between the starting materials and the final product materials. It is noted that the first and second materials can themselves be different.

In claim 23, the expression "involving the use of physical mask" is vague and indefinite.

Claim 25 is vague in requiring the step of "screening said array materials for a useful property" because it is not clear what useful property is intended.

Note: the Examiner, Group and Art Unit in charge of this application has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1618.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800

pa
March 28, 1999